

REMARKS

Claims 87-147 were pending in the application. Claims 133-147 have been canceled. Claims 88-93, 96-97, 99-100, 103, 105, 108-111, 116, and 121-122 have been amended. Claims 148-159 have been added. Therefore, claims 87-132 and 148-159 are now pending in this application.

Priority Claim

Applicant is not currently contending that the present claims are entitled to the benefit of the filing date of U.S. Appl. No. 08/784,829, or the filing date of any application to which the '829 application claims priority. Applicant is entitled to maintain the present priority claim, however. Because the '829 application is incorporated by reference in the present application, the present application maintains continuity of disclosure with respect to this subject matter. Accordingly, Applicant is entitled, for example, to file a continuing application from the present application that includes claims directed to subject matter found in the '829 application, and which would be entitled at least to the filing date of the '829 application.

Restriction Requirement

The Examiner has entered a restriction requirement as follows:

- I. Claims 87-92, drawn to financial institution receiving a pseudo credit account identifier that was established by the financial institution, classified in class 705, subclass 74.
- II. Claims 93-122, drawn to a privacy server configured to provide the seller fictitious payment information not usable to determine any of the set of information associated with the actual form of payment, classified in class 705, subclass 79.
- III. Claims 123-132, drawn to privacy server configured to facilitate a transaction such that each of the entities have access to at least one of but not all of the information, classified in class 705, subclass 74.

- IV. Claims 133-147, drawn to retrieving an alias payment information in response to receiving identifier from the seller and providing the alias payment information to the seller, classified in class 705, subclass 74.

More particularly, the Examiner has stated that “[i]nventions I and II, III,” “[i]nventions IV and I,” and “[i]nventions IV and II III” are each related as combination and subcombination. *See* Office Action at 3-4. Additionally, the Examiner alleges that “[I]nventions II and III” are related as subcombinations usable together. *See* Office Action at 5.

Applicant has canceled claims 133-147, identified by the Examiner as readable on group IV. As such, Applicant submits that the restriction between groups IV and I and between groups IV and II, III are now moot. With respect to the remaining restrictions (I and II, III; II and III), Applicants elects group I with traverse.¹ The Examiner has identified claim 87-92 as readable on group I. Applicant also submits that newly added claims 148-159 are also readable on group I.

As a basic matter, it is not entirely clear to Applicant which claims are alleged to constitute combination claims and which claims are alleged to constitute subcombination claims. For example, the Examiner has stated that groups II and III are “subcombinations usable together.” Accordingly, it appears that the Examiner believes that groups II and III constitute subcombination claims. The Examiner also alleges that groups IV and I are related as combination and subcombination. *See* Office Action at 3. Given the structure of this sentence, it appears that group IV claims are believed to be combination claims and group I claims are believed to be subcombination claims. However, earlier in the restriction, the Examiner alleges that “[i]nventions I and II, III are related as combination and subcombination.” *Id.* While it is not clear which of groups I, II, and III are believed to combination or subcombination claims, elsewhere in the restriction, the Examiner has identified *each* of groups I, II, and III as subcombination claims. Accordingly, the restriction requirement is believed to be internally inconsistent, and, as such, should be removed. *See* MPEP § 814 (“The Examiner must provide a clear and detailed record of the restriction requirement”).

¹ Nothing in the present remarks is to be taken as any type of statement or admission regarding the patentable distinctiveness of any of the pending claims vis-à-vis one another.

The Instant Restriction Requirement Improperly Restricts Method and System Claims

Group I claims are all method claims. Groups II and III claims are all system claims. Applicant therefore submits that groups I and II and groups I and III cannot have the relationships alleged by the Examiner. Subcombinations are separate, non-overlapping components of the same combination. Two separate apparatuses could be subcombinations of an apparatus combination, or two separate processes could be subcombinations of an overall process combination, but an apparatus and a process cannot be separate subcombinations of the same combination. In regards to restrictable related inventions, there are other sections of the MPEP that apply to related apparatuses and processes (see sections 806.05(e), 806.05(f), 806.05(h) and 806.05(i)), but “combination/subcombination” and “subcombinations disclosed as usable together in a single combination” (MPEP 806.05(d)) clearly do not apply to a group of apparatus claims and a group of method claims.

For at least this further reason, the restrictions between groups I and II, and between groups I and III are believed improper.

Additionally, Applicant submits that the Examiner has not established a “serious burden” if the restriction were not maintained. Even by the Examiner’s own classification, groups I and III are admittedly in the same subclass, and all groups are in the same class. It is not clear that separate searches need be performed.

Restriction Between Groups II and III

For subcombinations to be restrictable as subcombinations usable together, they cannot overlap in scope. *See* MPEP § 806.05(d). For example, a subcombination claim to a bicycle seat and a subcombination claims to a bicycle gear mechanism might be written so that they do not overlap in scope. Here, however, groups II and III, alleged to be restrictable as subcombinations usable together, *clearly overlap in scope*, as both groups include claims that recite “a privacy

server” (see, e.g., claims 93 and 123).² For at least this further reason, the restriction between groups II and III is believed improper.

² Again, the mere fact that two alleged groups overlap in scope is not to be construed as any type of admission regarding the patentable distinctiveness of groups II and III vis-à-vis one another; Applicant is merely noting that the Examiner has failed to make out a restriction requirement that follows the guidelines set forth in the MPEP.

CONCLUSION

Applicants submit the application is in condition for allowance, and an early notice to that effect is requested.

Applicant has petitioned herewith for what is believed to be the appropriate extension of time. If any further extensions are necessary to prevent the above-referenced application from becoming abandoned, Applicant hereby petitions for such extension.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 501505/6057-37702/DMM.

Respectfully submitted,

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By: /Dean M. Munyon/
Dean M. Munyon
Reg. No. 42,914
Attorney for Applicant

Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
(512) 853-8847